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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,238	04/17/2000	KENNARD L WOTTOWA	AND1P692	9703

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EXAMINER

POINVIL, FRANTZY

ART UNIT PAPER NUMBER

3628

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/551,238

Applicant(s)

WOTTOWA ET AL.

Examiner

Frantzy Poinvil

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-- The MAILING DATE of this communication app ars on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed 1/5/2004 have been fully considered but they are not persuasive.

2. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. (US Patent No. 6,354,490) and further in view of Nishimura et al. (JP404195256A).

Applicant's representative argues that Weiss does not teach or suggest the creation of an account remotely. In response, the claimed information does not call for or does not recite "creating of an account remotely". The account is created using a computer. The independent claims do not recite the account is created remotely. Independent claim 1 recites "utilizing the first computer to create an account". The first computer being used to create an account is also taught on column 6, lines 46-62 of Weiss. Claim 1 further recites "transmitting information relating to the created profile and account from the first computer to a second computer". It is noted that Weiss teaches that their system uses a computer network and that information is transferable from one computer to another computer. Note column 5, lines 15-20 of Weiss et al. Thus, Weiss et al suggest transferring customer profile and account data to another computer. As previously stated, a bank usually has a number of associated computers found in one or more location and at least one regional or central location. The profile information or account data can be created or transferred to a remote location. Nishimura et al disclose opening an account at a remote location and transmitting a notification from a host computer to a remoter terminal. See the abstract of Nishimura et al.

Applicant's representative also argues that their invention does not utilize two computers within the same internal network, but instead incorporates external computers to bank's internal network to complete the transaction and refers to claim 1.

In response, claim 1 does not recite such a limitation as applicant asserts.

Applicant further states that the combination of Weiss et al and Nishimura et al does not teach or suggest applicant's claimed invention of a separate computer creating the account , outside the host network.

The Examiner respectively disagrees with applicant's assertion because having a "separate computer creating the account outside the host network" is not present in the claimed invention. In the claimed invention, only one network is positively claimed and the customer profile and the customer account is created within that network by the first computer. The creating of an account is not being claimed to be created outside a host network. Assuming that the second computer is within a second network, the second computer does not create the customer profile or the customer account. The second computer merely transmits a notification to a customer.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (as noted above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. (US Patent No. 6,354,490) and further in view of Nishimura et al. (JP404195256A).

As per claims 1, 11 and 20, Weiss discloses a system in which a customer may use one of a plurality of devices including a personal computer to open an account at a financial institution. Note the abstract. A user may transmit account application including information related to the user and documentation related to the user. Note the abstract. A computer at the financial institution is used to create a profile for the customer based on the account application and to create an account for the customers. Note column 8, lines 57-68, column 90, lines 60-68 and column 6, lines 30-63 of Weiss. Weiss does not explicitly teach transmitting information relating to the created profile and account from a first computer to a second computer, and transmitting a generated notification from the second computer to the first computer. However, the Examiner asserts that it is well known in the banking industry for a bank to use more than one computer in their establishment and also to include a branch office and/or a regional

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office having at least one computer. It would have been obvious to one of ordinary skill in the art to also note that a branch office may transmit customers' account information to a regional office and the regional office may further update customers' information at the local, or branch office. Also, a final notification may also be made by the regional office or a related underwriter's office, which may transmit such to the branch office computer to be transferred or given to the customer.

Alternatively, Nishimura et al disclose a similar process. The system comprises a user at an automatic teller machine, ATM providing personal information that are stored in a RAM memory section of a computer. This information is later transmitted to a host computer 6 via an interface 46. The host computer 6 then generates a file and informs the opening of the account to an ATM 4. See the entire document. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Nishimura et al with Weiss in order to inform a remote customer of account information status. The motivation would have been to allow instant opening of an account thereby providing an attractive system.

As per claim 2, the combination of Weiss and Nishimura et al disclose utilizing a network.

As per claim 3, most customer accounts include an identifier associated with a particular customer so as to differentiate the different customers. The computers include a printer, which may be used for printing material with the identifier.

As per claims 4-6, most bank customers are usually identified by an identifier or identification. Generating an identifier associated with the customer utilizing the first computer

would have been obvious to the skilled artisan in order to differentiate the different customers and also for data storage and retrieval purposes.

As per claim 7, note column 12, lines 60-67 and column 13, lines 45-59 of Weiss.

As per claim 8, sending the notification to the user via an electronic mail (e-mail) message would have been obvious to one of ordinary skill in the art as the use of E-mail is well practiced in the art. Providing such in the combined teachings of Weiss and Nishimura would have been obvious to the skilled artisan in order to provide instant account status to a customer.

As per claims 9-10, as per the step of inputting at least a portion of the information included in the account application into the first computer prior to the generation of the customer profile, note column 9, line 40 to column 10, line 44 and column 11, lines 3-15 of Weiss.

As per claim 10, storing the created profile and account in a database coupled to the computer is taught on column 12, lines 26-30.

Claims 12-19 recite similar limitations addressed in respective claims 2-5 and 7-10, and therefore claims 12-19 are rejected under a similar rationale applied to claims 2-5 and 7-10 above.

4. *Applicant has submitted new claims 21-23 reciting “performing third party payments comprising: permitting the selection of a payee from a list and receiving payment information about the customer (see figure 6G of Weiss et al). Determining whether the payee and the customer each have an account with a common entity and adjusting the accounts of the customer and the payee if it is determined that the payee and customer both have accounts with the common entity is not explicitly taught by Weiss et al and Nishimura et al. It would have been obvious to one of ordinary skill in the art to note that such would have become evident when at least the first payment is initiated. Having accounts at a common entity would have facilitated the transfer of funds and the instant receipt of funds in the combination of Weiss et al and Nishimura et al.*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 for Before Final actions and (703) 872-9327 for After Final actions.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP
February 25, 2004


FRANTZY POINVIL
PRIMARY EXAMINER
443628